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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,625	01/09/2002	Francis Ambrose Broderick	FR920000074US1	4352

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IBM Corporation
INTELLECTUAL PROPERTY LAW
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EXAMINER

DESHPANDE, KALYAN K

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/042,625	BRODERICK ET AL.	
	Examiner	Art Unit	
	Kalyan K. Deshpande	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The following is a non-final office action in response to the communications received on January 9, 2002. Claims 1-8 are now pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-3 recite the limitations, "determining a number of IT sites spread over a geographic are", "determining the skilled people groups and computer equipment require inside geographic area", "consolidating the IT sites by considering costs", "determining best processes and methods", and "analyzing the image for determining the best processes and practices". These limitations are representative of subjective steps that may be performed in the mind of the user, thus raising the issue of abstract ideas that require undue experimentation for the invention to be performed. Since many of the steps of the claims use subjective questions to gather subjective answers, which are evaluated subjectively and lack a concise formula or description for how to evaluate the answers, one skilled in the art would have to conduct undue experimentation in

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order to perform the invention. Therefore, claims 1-3 are considered as failing to comply with the enablement requirement. Dependant claims 4-8 fail to cure claims 1-3 and are therefore considered as failing to comply with the enablement requirement as well.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is required to produce a useful, concrete, and tangible real-world result. An invention that fails to produce a tangible result is one that involves no more than the manipulation of an abstract idea. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). In order to be concrete the result must be substantially repeatable or the process must substantially produce the same result again.

Claim 1 merely recites the manipulation of an abstract idea and does not produce a concrete and tangible result. Claim 1 recites "determining a number of IT sites spread over a geographic are", "determining the skilled people groups and computer equipment require inside geographic area", and "consolidating the IT sites by considering costs", which are mere abstract ideas that do not produce real-world results. The steps of "determining a number of IT sites spread over a geographic are", "determining the skilled people groups and computer equipment require inside geographic area", and

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“consolidating the IT sites by considering costs” are based on subjective standards.

The results of this step will not produce concrete real-world results since there is no evidence that this step, when repeated, will produce substantially the same result. This step is based on a subjective standard and will produce different results for each individual performing the step. Furthermore, the results of these steps do not produce a tangible result. The result of these steps is the “consolidation of IT sites based on project cost parameters and geographic site location peculiarities” is not a real-world tangible result. Because the results produced by the method are not tangible and concrete, claim 1 is considered to be directed toward non-statutory subject matter.

Claim 2 also merely recites the manipulation of an abstract idea and does not produce a concrete result. Claim 2 recites “determining best processes and methods”, which is a mere abstract idea that does not produce real-world results. The step of “determining best processes and methods” is based on subjective standards. The results of this step will not produce concrete real-world results since there is no evidence that this step, when repeated, will produce substantially the same result. This step is based on a subjective standard and will produce different results for each individual performing the step. Because the results produced by the method are not concrete, claim 2 is considered to be directed toward non-statutory subject matter.

Claim 3 merely recites the manipulation of an abstract idea and does not produce a concrete and tangible result. Claim 3 recites “analyzing the image for determining the best processes and practices”, which is a mere abstract idea that does not produce real-world results. The step of “analyzing the image for determining the best processes

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and practices” is based on subjective standards. The results of this step will not produce concrete real-world results since there is no evidence that this step, when repeated, will produce substantially the same result. This step is based on a subjective standard and will produce different results for each individual performing the step. Furthermore, the results of these steps are not tangible. The result of “analyzing the image for determining the best processes and practices” is not a real-world tangible result. Because the results produced by the method are not tangible and concrete, claim 3 is considered to be directed toward non-statutory subject matter.

Claims 4-8 recite subject matter already addressed by the rejection of claims 1-3 without curing the limitations towards statutory subject matter; therefore the same rejections apply to these claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alter (Alter, Steven; *Information Systems: A Management Perspective*, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996).

As per claim 1, Alter teaches:

A project management method for optimizing Information Technology (IT) sites including skilled people groups and computer equipment, said method comprising the steps of:

determining, according to a project business need, a number of IT sites spread over a geographic area (see pp. 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines.);

determining, according to a project technical need, the skilled people groups and computer equipment required inside the geographic area (see p. 557; where distinct roles are assigned to specific personnel who have the requisite skill set to perform the assigned tasks);

grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area (see pp. 557 and 564-65; where skilled personnel are grouped in to general roles.

Equipment and personnel are distributed based on technical constraints. The technical constraints include decentralized systems that account for local variances versus centralized systems that perform cross-departmental functions well).

Alter fails to explicitly teach consolidating IT sites based on cost parameters and site peculiarities. Alter does teach, however, applying cost-benefit analysis for the project and accounting for commonly overlooked costs regarding hardware and site preparation such as re-wiring a site (see pp. 570-572). Consolidating IT sites based on

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costs and location peculiarities is part of Alter's teaching of commonly overlooked costs and costs associated with site preparation. The advantage of consolidating IT sites based on costs and location peculiarities is that it improves the project and system efficiency. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to account for consolidate IT sites based on cost and location peculiarities from Alter's teachings of common costs and commonly overlooked costs in order to increase the efficiency of both the project and the system, which is a goal of Alter (see p. 570).

As per claim 2, Alter teaches:

The method of claim 1, further comprising the step of process and method standardization before the consolidating step, said process and method standardization step comprising the steps of:

listing processes and methods used in the IT sites as determined (see pp. 559 and 565-566; where corporate standards and procedures are determined);

listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed (see pp. 570-574; where assessment of efficiency is determined using multiple standards and procedures);

determining best processes and methods according to values of said criteria; and (see pp. 565-566 and 570-574; where best practices are determined and implemented and can be based on efficiency),

implementing the best processes and methods in the IT sites as determined.

As per claim 3, Alter teaches:

The method of claim 2 wherein the step of determining the best processes and method further comprises the steps of:

creating with a graphic user interface an evolutionary image of the values of the criteria (see p. 573; where a graph displaying costs, benefits and cumulative net benefit is created for a project); and

analyzing the image for determining the best processes and methods (see p. 573; where the image is analyzed to determined the value of the project).

Alter fails to explicitly teach entering the values into a database. It is old and well-known in the art to enter data into a database after it has been collected so that the data can be pulled to generate graphs and reports. The advantage of storing the data in a database is that the data can be easily accessible, thereby increasing the efficiency of the system. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to store data in to a database in order to increase the overall system efficiency, which is a goal of Alter (see p. 570).

As per claims 4 and 5, Alter fails to explicitly teach repeating the steps of listing criteria, determining best processes and methods, and implementing the best processes and practices. It is old and well known in the art to repeat steps in a process. The advantage of repeating steps is that repeating critical steps ensure the accuracy of the result of the steps. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to repeat the steps of listing criteria, determining the best

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processes and practices, and implementing the best processes and practices in order to ensure the accuracy of the results of the steps, which is a goal of Alter (see p. 570).

As per claim 6, Alter teaches:

The method of claim 1 wherein the IT sites are spread over more than one geographic area (see pp. 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines.).

As per claim 7, Alter teaches:

The method of claim 1, further comprising a step of determining, before the step of determining skilled people groups and computer equipment, a management organization for the geographic area (see p. 557; where project manage roles are assigned. Each IS department or region is accounted for).

As per claim 8, Alter teaches:

The method of claim 1, further comprising after each step, a step of updating a project management tool displaying a time for executing each step of the method of claim 1 (see p. 576; where a Gantt chart is a tool used to display a time for executing steps of a project).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are pertinent to the current invention, though not relied upon:

Willemessen (Willemessen, Joel; "Information Technology Management: Small Business Administration Needs Policies and Procedures to Control Key IT Processes", GAO Reports, July 20, 2000) teaches policies, processes and practices for the implementation of IT processes for small businesses.

Irani et al. (Irani, Zahir; Love, Peter E.D.; "The Propagation of Technology Management Taxonomies for Evaluation Investments in Information Systems", *Journal of Management Information Systems*, 2000, pp. 161-177) teaches a method for determining the direct and indirect costs of information systems.

Benamati et al. (Benamati, John; Lederer, Albert; "Rapid Change: Nine Information Technology Management Challenges", *INFOR*, November 2000, pp. 336-358) teaches a strategy to implement information technology systems.

Knudson et al. (U.S. Patent No. 5765140) teaches a project planning tool is used to effect the project plan including a plurality of tasks to be performed by the users in accordance with respective time schedules.

Hongawa (U.S. Patent No. 5974391) teaches a device for generating a Gantt chart made up of at least one schedule bar includes, a display showing the Gantt chart, an input unit receiving input to point at a position on the display, a Gantt-chart-generation processing unit generating a schedule bar having a start point and an end point by setting the start point at a first position indicated by the input unit and setting the end point at a second position indicated by the input unit, and a work-step-division

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processing unit dividing the schedule bar into a plurality of work steps at a plurality of third positions indicated by the input unit.

Oliver (U.S. Patent No. 5907490) teaches a system for monitoring and assessing the performance of a project includes a computer and a software program associated with the computer, with the software program and computer operable in combination to receive project task data from a project management software file, determine current earned value (EV) information from the project task data, and graphically displaying the earned value information.

Wood (U.S. Patent No. 5381332) teaches a bridge is provided between a conventional network scheduling tool and a conventional performance measurement tool which automatically ties the two together.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571) 272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


kkd


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